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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,215	04/12/2004	David S. Rathbun	8932-890-999	1597

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JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,215

Applicant(s)

RATHBUN ET AL.

Examiner

David Comstock

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44,46-48 and 56-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,13-24,31-41,46-48,56 and 57 is/are rejected.
- 7) ☒ Claim(s) 7-12,25-30,42-44 and 58-63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Pre-Appeal Brief Review

The following action is pursuant to the panel decision from the pre-appeal brief review on 24 January 2006. The finality of the action mailed 22 September 2005 is withdrawn and new rejections and remarks follow.

Information Disclosure Statement

The information disclosure statement filed 29 August 2005 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not necessarily been considered.

Claim Objections

Claim 48 is objected to because of the following informalities: line 2, ".0.5 mm" should be changed to --0.5 mm-- to remove the extra decimal or period mark.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 13-15, 17-22, 31-33, 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Brace et al. (6,342,057; cited by applicant).

Brace et al. disclose a drill guide 100 comprising a guide barrel, e.g. 136, joined to an alignment assembly 138 (see Figs. 1 and 2). The guide barrel has a bore and the alignment assembly comprises a plurality of resilient fingers 206 having a ridge at the distal end thereof for locking to a bone plate 254 having screw holes and a recess 252 (see Fig. 12). A handle 112, 114 is associated with the guide barrel and is rotatable with respect to the guide barrel in a first plane either taken through the handle and the barrel (i.e. movement or actuation of the handle members 112, 114) or taken perpendicularly to the axis of the barrel bore (i.e. rotation of the entire device about the axis of the barrel bore). The device includes a swivel assembly (e.g. 124, 158) having a locked and unlocked position. Any of the openings of the assembly such as the slot for portion 158 can be considered a drain hole. The location post is axially fixed to the alignment assembly. The guide barrel and alignment assembly have different lengths.

Claims 1, 5, 6, 13, 14, 19, 23, 24, 31, 32, 37-41, 46, 56 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Brace et al. (6,342,057; cited by applicant).

(Note: this rejection differs from the rejection under 35 USC 102(b) over Brace et al. that was already applied above in the interpretation of the alignment assembly.)

Brace et al. disclose a drill guide 100 comprising a guide barrel, e.g. 136, joined to an alignment assembly (see Figs. 1, 2 and 7). The guide barrel has a bore and the alignment assembly includes a location post 138 slidably received within an axial bore of a housing 206 (see Fig. 7). The location post has an extended and retracted position relative to the housing. The end of the guide barrel can be considered a depth stop since it is a surface that is capable of preventing a corresponding tool from passing therebeyond. A handle 112, 114 is associated with the guide barrel and is rotatable with respect to the guide barrel in a first plane either taken through the handle and the barrel (i.e. movement or actuation of the handle members 112, 114) or taken perpendicular to the axis of the barrel bore (i.e. rotation of the entire device about the axis of the barrel bore). The device includes a swivel assembly (e.g. 124, 158) having a locked and unlocked position. Any of the openings of the assembly such as the slot for portion 158 can be considered a drain hole. The guide barrel and alignment assembly have different lengths.

Claims 37-40 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Caspar et al. (5,669,915; cited by applicant).

Caspar et al. disclose a drilling assembly comprising a guide barrel 6 with a stop 20, a location post 8 and housing (e.g., the other barrel), and a substantially

perpendicular handle that is pivotable with respect to the guide barrel (see, e.g., Fig. 1). A bone plate 29 includes a hole and alignment recess (i.e., the holes). The axis of the post is at a distance from an axis of the guide barrel, and a hole and recess of the bone plate are a distance from each other. The housing and guide barrel are pivotally connected together via arms 3 and a screw 5. The housing and guide barrel form an integral assembly--i.e. they form a unit, a whole possessing every essential element (see definition of *integral* in The American Heritage Dictionary at [answers.com](http://www.answers.com) <http://www.answers.com/topic/integral?method=6>). Thus, it is noted, to be "integral" as presently claimed, the device must form a unit or possess every essential element and does not need to be one solid piece in construction or any other such interpretation that applicant may have intended. It is also noted that applicant has not defined the term "integral" in any way to necessitate a special interpretation outside its ordinary meaning.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 34, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brace et al. (6,342,057; cited by applicant).

Brace et al. disclose the claimed invention except for explicitly disclosing the device comprising a non-metallic bearing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device with a

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bearing of a known material other than metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It also would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the relative distances (between the bore axis and the location post axis) in a range between 0 and 0.8 mm or of about 0.5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Allowable Subject Matter

Claims 7-12, 25-30, 42-44 and 58-63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments pertaining to Caspar et al. filed 20 December 2005, see Remarks, page 3, lines 4-30, with respect to independent claim 1, and page 4, lines 5-24, with respect to independent claim 19, have been fully considered and are persuasive. Accordingly, the rejections over Caspar et al. of claims 1 and 19 and claims dependent thereon have been withdrawn. The rejection of claims 37 and 46 over Caspar et al. has been modified but maintained in the present non-final action. In addition, upon further consideration, new grounds of rejection have been made in view of Brace et al. as set forth above.

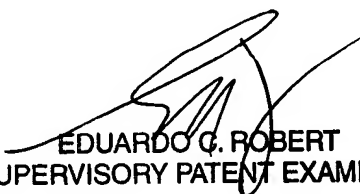
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock
10 February 2006



EDUARDO G. ROBERT
SUPERVISORY PATENT EXAMINER